Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 50277-2433

CERTIFICATE OF TRANSMISSION VIA EFS-WEB	Application Number 10/830,211	Filed April 21, 2004
Pursuant to 37 C.F.R. 1.8(a)(1)(ii), I hereby certify that this correspondence is being transmitted to the United States Patent & Trademark Office via the Office electronic filing system in accordance with 37 C.F.R. §§1.6(1)(4) and 1.8(a)(1)(i)(C) on the date indicated below and before 9:00 PM PST.	First Named Inventor Fei Ge, et al.	
Submission date: February 26, 2009 by Howard H. Louie	Art Unit 2168	Examiner Morrison, Jay A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.
YES

The review is requested for the reason(s) stated on the attached sheet(s).
        Note: No more than five (5) pages may be provided.

I am the

☐   applicant/inventor.

☐   assignee of record of the entire interest.
     See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
     (Form PTO/SB/96)

☒   attorney or agent of record.
     Registration number 60,820   .

☐   attorney or agent acting under 37 CFR 1.34.

     Registration number if acting under 37 CFR 1.34

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Typed or printed name

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February 26, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒   *Total of 1_____ forms are submitted.

Pre-Appeal Brief Conference Arguments

Application number: 10/830,211
Title: "Cost-Based Optimizer for an XML Data Repository within a Database"
Filed: April 21, 2004

CLAIM 1

Claim 1 appears as follows:

1.   A method comprising the computer-implemented steps of:
gathering statistics by a database server about nodes that are stored in a database
        repository that is managed by the database server;
wherein said nodes form a hierarchy;
wherein each node is either an XML file or a container;
storing said statistics; and
in response to a request to the database server for access to one or more XML
        resources from said database repository, the database server computing a
        computational cost associated with each of two or more methods of
        accessing said one or more XML resources from said database repository,
        based on said statistics.

To support the current anticipation rejections made under 35 U.S.C. § 102(b), the Examiner alleges that Jagadish discloses "wherein said nodes form a hierarchy; wherein each node is either an XML file or a container". The Examiner clearly erred in alleging that Jagadish discloses these features of Claim 1. Jagadish does not suggest or disclose these features of Claim 1, nor are these features inherent in Jagadish. Thus, the Examiner has failed to establish a prima facie anticipation rejection under 35 U.S.C. § 102(b).

Jagadish discusses storing XML documents using a database system. In Jagadish, the tree structure of an XML document (i.e. the hierarchical relationships between the elements **within an XML document**) is retained in storage. However, what Jagadish shows:

*   a hierarchy between **elements within an XML document**

is very different than what Claim 1 expressly requires:

*   a hierarchy between **XML documents themselves** (or containers of XML documents).

While Jagadish shows the former, Claim 1 requires the latter.

Claim 1 does not simply require storing XML documents so that the **internal** tree structure of each XML document is retained in storage. Instead, in Claim 1, the nodes of the hierarchy **are** XML files or containers.

Jagadish does not disclose or suggest any hierarchy in which each node is either an XML file or a container. Footnote 4 on page 280 of Jagadish says (emphasis added) "The database is a **single** tree document". Section 4 of Jagadish discusses that "[a]n XML document is a tree" and "each node in a tree represents an XML **element**". Thus, in Jagadish, the stored nodes are similar to the nodes of a DOM tree that represent an XML document. See section 3.1, paragraph 2. These portions cited from Jagadish show that, in Jagadish, a single XML document is stored as a tree structure, and not that each node of a hierarchy is either an XML file or a container, as recited in Claim 1.

The Examiner argues "note that the elements in xml data can be considered nodes within the xml hierarchy". While this statement is true (the elements of an XML document can be considered nodes in an XML hierarchy), it has nothing to do with the expressly claimed hierarchy, in which each node is either an XML file or a container.

The Examiner does not even argue that the features of Claim 1 that are missing from Jagadish are inherent in Jagadish. Even if the Examiner were to argue that the required features of Claim 1 are inherent in Jagadish, MPEP § 2112 quotes *In re Robertson* regarding inherency: "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it will be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." See *Ex parte Levy.*

Even if the Examiner were to argue that, in Jagadish, each XML element may be an XML file that is a node of a hierarchy, such an argument would still not properly establish inherency of disclosure in Jagadish. One of ordinary skill in the art would recognize that it would be inefficient and impractical to have a database repository that stores nodes where each node is an XML element that is also an XML file. The Examiner has provided no extrinsic evidence to indicate that, in Jagadish, each node of a stored hierarchy is <u>necessarily</u> an XML file or a container. The Examiner's argument

that, in Jagadish, elements in XML data <u>can</u> be considered nodes within the XML hierarchy is insufficient to establish inherency, especially given the lack of any suggestion or disclosure in Jagadish that each XML element is <u>necessarily</u> an XML file.

Since such features of Claim 1 are not inherent, and are not actually disclose in Jagadish, the Examiner has clearly erred and failed to establish a prima facie case of anticipation under 35 U.S.C. § 102(b).